

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated August 5, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1, 2, 4-8 and 12-15 are pending in the application. Claims 3 and 9-11 are canceled herein, without prejudice. The Applicants respectfully reserve the right to reintroduce subject matter deleted herein, either at a later time during the prosecution of this application or any continuing applications.

In the Office Action, claim 3 is objected to and claims 9-11 are rejected. It is respectfully submitted that the cancellation of claims 3 and 9-11 herein renders this objection and rejection moot.

In the Office Action, claims 5 is maintained rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. It alleged that claim 2 recites that the boot sector is stored within the storage unit. It is respectfully maintained that claim 2 recites no such limitation. While claim 2 does recite a method of downloading software programs into a storage unit, claim 2 makes clear that the software programs

include a boot code and an application code yet does not recite that the boot code is a portion of the software programs stored in the storage unit. While claim 2 does recite that a boot sector is defined, again claim 2 does not require that the boot sector be defined within the storage unit.

FIG. 3 is amended herein to attempt to address the concerns raised in the Office Action. Consideration and admittance of FIG. 3 as amended herein is respectfully requested. The specification is also amended to refer to the changes in FIG. 3. Consideration and admittance of the amendments to the specification as amended herein is respectfully requested.

It is respectfully submitted that these changes to the figures and the specification are well supported by the Application as originally submitted. For example, the specification on page 6, lines 29-30 makes clear that "the boot sector is preferably located in a protected storage area, which may be inside the storage unit or separate from the storage unit." Accordingly, in the specification it is sufficiently described to enable a person skilled in the art to appreciate that two separate embodiments are envisioned by the Applicants, one embodiment wherein the boot sector is located inside the storage unit and another embodiment

wherein the boot sector is separate from the storage unit. Each embodiment is now shown with reference to FIG. 3 as amended.

Accordingly, it is respectfully submitted that with the amendments and explanation provided herein, claim 5 complies with the enablement requirement. Accordingly, withdrawal of the rejection of claim 5 under 35 U.S.C. 112, first paragraph is respectfully requested.

The Office Action rejects claims 13 and 14 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicants respectfully disagree with and explicitly traverse these grounds for rejecting claims 13 and 14. It is the Applicants' position that the claims require statutory subject matter. However, in the interest of furthering the prosecution of this matter, Applicants have elected to amend the claims to more clearly state the invention. Specifically, Applicants have amended claim 13 to more clearly state a computer program stored on a computer readable memory device which when received by a receiver, configures the receiver to carry out the method as claimed in any one of claims 1 to 8. Applicants have amended claim 14 to more clearly state a computer program signal stored on a computer readable memory device, the computer program signal being arranged

to configure a processor to carry out the method as claimed in claim 1. The Office Action alleges that no computer readable memory device is described in the specification other than a signal. This position is respectfully refuted. In fact, in the section cited by the Office Action, it is stated that (emphasis added) "[i]t also relates to a computer program product for carrying out the method mentioned above and to a signal for carrying the computer program." By the plain language of the specification, clearly both a computer program product and a signal are contemplated by the present invention.

Accordingly, clearly claims 13 and 14 require statutory subject matter that is supported by the specification. Accordingly, it is respectfully requested that the rejection of claims 13 and 14 be withdrawn.

Claims 1-15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2001/0011347 to Narayanaswamy ("Narayanaswamy") in view of U.S. Patent No. 6308,265 to Miller ("Miller"). This rejection is respectfully traversed. It is respectfully submitted that claims 1, 2, 4-8 and 12-15 are allowable over Narayanaswamy in view of Miller for at least the following reasons.

Narayanaswamy shows a memory system that utilizes two boot code units 22, 24, one being active and the other being inactive (see, FIG. 2, paragraph [0018]). Narayanaswamy maintains each of the boot code units with one storing an active boot code block and the other storing the inactive boot code block (see, paragraph [0024]). New boot code is written into the boot code unit that is inactive and thereafter, the inactive boot code unit is made the active boot code unit (see, FIG. 4A, paragraph [0027]).

Miller shows a vastly different and incompatible solution to Narayanaswamy, wherein the original boot block is overwritten by a new boot block. In Miller, prior to writing over an existing boot block, a copy of the boot block from a first region (see, FIG. 2, block 200-1) is copied to another region (see, FIG. 2, block 200-2). After confirming that the original boot block and the copy are identical, new boot data is written over the original boot block (see, abstract and FIG. 3). FIG. 2 shows a memory in accordance with the teachings of Miller. In FIG. 2, the boot code block is stored in block 200-1 along with an updatable portion of the BIOS that extends from block 200-1 to 200-2 (see, Col. 5, lines 6-18). The original boot block and updatable portion of the BIOS is copied over the updatable portion of the BIOS that extends into the

section 200-2 (see, FIG. 3, step 300, and col. 5, lines 52-55). Thereafter, the original boot block is overwritten (erased during step 340 and updated during step 350) with new boot data.

Each of these different solutions ensures that a bootable system is available in case of problems with updating the boot code. Narayanaswamy does this by only writing over an inactive code block in the inactive code unit. Miller does this by copying the active boot code block from a first region to a second region, and then writing over the boot code block in the first region.

The Office Action finds motivation for combining Narayanaswamy and Miller stating that "[t]he motivation to do so is to ensure that the correct boot code is stored in the first region before write protecting it and erasing a valid downloaded copy of the updated boot code stored in the second region." This position is respectfully refuted. There is no motivation to combine Narayanaswamy and Miller. In addition, the reconstruction suggested can find not proper motivation in either of Narayanaswamy and Miller.

Each of Narayanaswamy and Miller already ensure that a backup copy of the boot code is available in case of power failure without the modification suggested in the Office Action.

It is respectfully submitted that for the above rejection, the Office Action cites a motivation to make a combination of references that finds no support in the cited references.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also In *re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In *re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." In *re Lee*, 277 F.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." *Id.* "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In *re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not

sufficient to establish a genuine issue of material fact."
Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617, citing **McElmurry v. Ark. Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Office Action that the combinations of prior art references "would be obvious to one having ordinary skill in the art ... " is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention.

The stated motivation for combining the references is nowhere recognized in the prior art and in fact, each of Narayanaswamy and Miller solve the problem stated as motivation and therefore no such motivation exists.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

The mere fact that the prior art device could be modified so as to produce the claimed device, which in this case even in combination it does not, is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Office Action espouse that this reconstruction forwarded does not include knowledge gleaned only from the applicant's disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art since each already addresses the problem espoused as the motivation for the combination of Narayanaswamy and Miller.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own

reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

Applicant would like to bring to the Examiner's attention well established case law that clearly shows that the court frowns on such use of hindsight, examples of such cases being as follows:

It is stated in *In re Sernaker*, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983): "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

It is clear that the suggestion to combine references should not come from the Applicants, as was forcefully stated in *Orthopedic Equipment Co. v United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983): "It is wrong to use the patent in suit [here the application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

Also, the case law is clear in guarding against the use of hindsight in reading Applicants invention into the prior art, which art is clearly not disclosing the Applicants invention as claimed.

Applicants would like to bring the following cases to the Examiner's attention:

The Supreme Court in *Calmar, Inc. v. Cook Chemical Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), in which the Court warns the dangers of "slipping into hindsight", citing the case of *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir., 1964), where the doctrine is stated (emphasis added):

We now come to the patented device which after all is the subject matter of this case. At the outset we take note of two well-established principles. The first is that in considering the questions of obviousness, we must view the prior art from the point in time prior to when the patented device was made. Many things may seem obvious after they have been made and for this reason courts should guard against slipping into use of hindsight. We must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of *Sporck*, 301 F.2d 686, 689 (C.C.P.A).

The courts have long held that there must be some teaching in the references cited to suggest the combination of the references in a manner to obtain the combination of elements of the rejected claim(s).

As was further stated in *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "where prior art references

require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the lack of a motivation to combine the cited references since each already addresses a problem of power failure by maintaining a back-up copy of the boot code until the new boot code is verified as discussed above, that none of the suggested combinations of prior art utilized to reject each of claims 1, 2, 4-8 and 12-15 finds proper motivation for combination. Further, since the Office Action acknowledges that the prior art alone does not show the claimed features, it is respectfully requested that claims 1, 2, 4-8 and 12-15 be allowed and an indication to that effect is respectfully requested.

Further, it is respectfully submitted that even in combination, the system of Claim 1 is not anticipated or made obvious by the teachings of Narayanaswamy in view of Miller. For example, Narayanaswamy in view of Miller does not disclose or

suggest, a system that amongst other patentable elements, comprises (illustrative emphasis provided) "a current boot code in a first location, the method comprising the following steps: upon a download request, downloading a new boot code in a second location, which does not overwrite the current boot code and does overwrite a current application code, indicating that the new boot code in the second location replaces the current boot code, writing the new boot code in place of the current boot code in the first location, indicating that the new boot code written in the first location replaces the new boot code written in the second location, downloading a new application code associated to the new boot code in a location, which does not overwrite the new boot code in the first location, indicating that the new application code is valid" as recited in claim 1, and as substantially recited in claim 2.

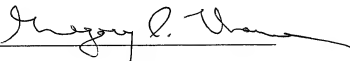
Based on the foregoing, the Applicants respectfully submit that independent claims 1 and 2 are patentable over Narayanaswamy in view of Miller and notice to this effect is earnestly solicited. Claims 4-8 and 12-15 respectively depend from one of claims 1 and 2 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the

claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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Enclosure: Replacement drawing sheet (1 sheet including FIG. 3)

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